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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,478	07/21/2003	Jean-Christophe Simon	032487-004	4522

7590 01/12/2007  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, VA 22313-1404

EXAMINER
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HUGHES, ALICIA R

ART UNIT	PAPER NUMBER
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1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	01/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/622,478	SIMON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alicia R. Hughes	1614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-55 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-48, drawn to a cosmetic makeup composition, classified in class 424, subclass 401.
- II. Claims 49-52, drawn to a regime or regimen for cosmetically making up a support, classified in class 424, subclass 401.
- III. Claims 53 and 54, drawn to skin, lips, hair or integuments, treated with a goniochromatic/light reflecting cosmetic makeup composition, classified in class 424, subclass 401.
- IV. Claim 55, drawn to a kit for making up the skin, lips, hair or integuments, classified in class 424, subclass 401.

Inventions I, II, III, and IV are related as product (I, II, and IV) and process of use (II). The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the inventions are related in that the process in Invention II can be utilized to apply the product in Invention I, which can be contained in the kit of Invention IV and applied to the parts of the body in Invention III.

The inventions are distinct, however, in that the cosmetic makeup composition in Invention I can be utilized with different regimens from those in Invention II or as part of a kit that is different from that in Invention IV or applied to skin, lips, hair and/or

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integuments that are not, per se treated with a goniochromatic/light reflecting makeup composition. Similarly, a different kit for making up the skin, lips, etc. from the kit listed in Invention IV can be in association with the treated skin, lip, hair or integuments listed in Invention III.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter and require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

#### ***Rejoinder Notice***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims

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and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Specie Election***

This application contains claims directed to the following patentably distinct species, should Applicant elect Invention I, and a choice of one from each of the following 4 species is required to be elected for examination:

- 1) Substrate – one or more materials, organic substrates, mineral substrates, glasses, ceramics, metal oxides, aluminas silicas, silicates, aluminosilicates, borosilicates, and synthetic mica (subspecie election required, *infra*).
- 2) A metal or metal compound – Ag, Au, Cu, Al, Zn, Ni, Mo, Cr, titanium oxides, iron oxides, tin oxides, barium sulfate, MgF<sub>2</sub>, CeF<sub>3</sub>, ZnSe, SiO<sub>2</sub>, Al<sub>2</sub>O<sub>3</sub>, MgO, Y<sub>2</sub>O<sub>3</sub>, SeO<sub>3</sub>, SiO, HfO<sub>2</sub>, ZrO<sub>2</sub>, CeO<sub>2</sub>, Nb<sub>2</sub>O<sub>3</sub>, Ta<sub>2</sub>O<sub>3</sub>, and MoS<sub>2</sub>.
- 3) A multilayer interference structure, as listed in claims 31 and 32.
- 4) A makeup composition - lip gloss, lip makeup, nail varnish, foundation, or mascara.

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The species are independent or distinct because, in the case of the makeup compositions, because of locations of dermatological application, for example mascara to the eyelashes and makeup to the lips, a search for one composition would not necessarily yield search results for another. In the case of the substrates, because their uses may vary in application to varied disciplines, a search for one would not necessarily yield results for the other. For example, ceramics may be utilized in making dental fixtures while silicates, breast implants.

In the case of the metals and metal compounds and as well, the multilayer interference structures comprised by these metals and metal compounds, again, a search for one will not necessarily yield results for the other, because various metals and metallic compounds, based on their chemical and physiological qualities, are more adaptable for certain purposes than for others. For example, barium sulfate is often used in the diagnosis of acute diseases of the small intestine or as an unabsorbable fecal marker, *see e.g.* "The Use of Barium Sulfate Suspensions in the Diagnosis of Acute Diseases of the Small Intestine" [hereinafter referred to as "Nelson et al" and the "Use of Barium Sulfate as an Unabsorbable Fecal Marker" [hereinafter referred to as Figueroa et al]], while aluminum oxide at high speed has been found to be effective at removing dental structures. *See e.g.*, "Dental Enamel, Qualitative Evaluation of the Surface After Application of Aluminum Oxide (Microetching) Using the Scanning Electron Microscope" [hereinafter referred to as "Silva et al"] and In consideration of the foregoing, election is most proper

The applicant is required under 35 U.S.C. 121 to elect a single disclosed species within each group for prosecution on the merits to which the claims shall be restricted if

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no generic claim is finally held to be allowable. In addition to the above election requirement under 35 U.S.C. 121, regardless of the substrate Applicant elects, Applicant must elect a subspecies, with specificity, that is provided in the specification, so as not to add new matter. As noted with the species above, so too, a search for one subspecies will not necessarily yield results for another. Currently, claims 1-55 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected in each group consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP §809.02(a).

Applicant is advised that in order for the reply to this requirement to be complete, it must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

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Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

### ***Inventorship Notice***

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is not longer an inventor of at least one claim remaining in the application. Any amendment of the inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Hughes whose telephone number is 571-272-6026. The examiner can normally be reached from 9:00 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for



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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Public PAIR only. For information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

8 January 2007  
ARH

  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER